



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/627,200

07/25/2003

Michael J. Walsh

040014-0178

2702

26371

7590

12/23/2005

FOLEY & LARDNER LLP
777 EAST WISCONSIN AVENUE
SUITE 3800
MILWAUKEE, WI 53202-5308

EXAMINER

NICOLAS, FREDERICK C

ART UNIT

PAPER NUMBER

3754

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No. 10/627,200	Applicant(s) WALSH ET AL.	
	Examiner Frederick C. Nicolas	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
 4a) Of the above claim(s) 13 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-36, 38-41 and 45-48 is/are rejected.
- 7) ☒ Claim(s) 42-44 is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03 & 5/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Drawing Fig. 9</u> . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species B: Figures 12-15, claims: 1-12,14-36,37-48 in the reply filed on 10/19/2005 is acknowledged. The traversal is on the ground(s) that the examination of both Species A and B can be completed with a single search and does not represent a burden. This is not found persuasive because the two species of claimed invention are clearly not related in terms of their modes of operation. For example, in the elected species of Figures 12-15, the upper edge of the spout being disposed at a second elevation greater than the first elevation of the outer edge. On the other hand, in the non-elected species of Figures 1-11, the upper edge of the spout being disposed at the same elevation as of the outer wall upper edge. Clearly, there exist unrelated features among the species of claimed invention, which will require a separate search area for each species and thus, impose a burden in search and examination for the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13 and 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/19/2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12,14-20,22-32,41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ekkert et al. 5,435,467.

Ekkert et al. disclose an insert (200) for a container (12), which comprises an outer wall having an upper edge (see Figure 9 for location of the outer wall, along with the upper edge), the upper edge being disposed at a first elevation as seen in Figure 9, an upstanding spout (202) located within the outer wall, the spout including at least one substantially straight portion (212), the straight portion having a lower edge and a substantially straight upper edge as seen in Figure 10, the upper edge of the spout being disposed at a second elevation greater than the first elevation as seen in Figure 9, a bottom wall connecting the lower edge of the outer wall and the lower edge of the spout to form a channel between the outer wall and the spout as seen in Figures 9-10, the spout includes at least three substantially straight portions (208,210,212), the lower edge of at least one of the three substantially straight portions gradually changes elevation along the length of the lower edge (col. 5, ll. 6-17).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ekkert et al. 5,435,467 in view of Nottingham et al. 2002/0195471.

Ekkert et al. have taught all the features of the claimed invention except that the liquid being a liquid coating. Nottingham et al. teach the use of a container (50) having a liquid, where the liquid being a liquid coating (col. 1, paragraph 0008).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the liquid product of Ekkert et al. with the liquid product of Nottingham et al, in order to provide a container for storing liquid coating materials.

7. Claims 35-36,38-40,45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nottingham et al. 2002/0195471 in view of Ekkert et al. 5,435,467.

Nottingham et al. disclose a paint container (50), which comprises a body (51) including a top portion (86), a flat side (54) having a recess portion to receive a label, an arcuate side (col. 3, paragraph 0060), the top portion having an opening extending therethrough as seen in Figure 1, a spout (150) coupled to the body and cooperating with the opening in the top portion, the spout being spaced apart from the body and having a first wall (172) with a pouring edge proximate the arcuate side of the body, a bottom wall (164) located between the body and the spout, wherein the body, the spout, and the bottom wall form a channel between the body and the spout as seen in Figure 13, a bail handle (120). Nottingham et al. lack that the first wall is provided with a straight pouring edge. Ekkert et al. teach the use of a spout (202) having a first wall

(208,210,212), where the first wall is provided with a straight pouring edge as seen in Figure 9.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the spout of Nottingham et al. with the spout of Ekkert et al., in order to increase the control and direction of product during pouring, as taught by Ekkert et al. in (col. 9, ll. 3-41).

With respect to claim 40, the claimed subject matter, "wherein the body of the container is substantially D-shaped".

It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the shape of the container of Nottingham et al. and Ekkert et al. to be D-shaped, since it has been held that a change in the shape of the element involves only routine skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).

8. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ekkert et al. 5,435,467 in view of Sprick 5,794,803.

Ekkert et al. disclose a container (12), which comprises a body defining a partially enclosed volume having an access opening (14), an insert (200) comprising an upstanding peripheral wall as seen in Figure 9, an upstanding spout (204) located within the peripheral wall, a first straight portion (212), a second straight portion (208), the straight portion having a lower edge and a substantially straight upper edge as seen in Figure 10, the upper edge of the spout being disposed at a second elevation greater than the first elevation as seen in Figure 9. Ekkert et al. lack that the insert being integrally formed with the body. Sprick teaches the use of an insert (14) being integrally

formed with a container (12) body (18), where the insert is spin-welded to the body (col. 2, ll. 37-46).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize Sprick's teaching onto the insert of Ekkert et al. by integrally formed the insert with the container body as taught by Sprick in (col. 2, ll. 37-46), in order to prevent leakage between the insert and the container opening.

Allowable Subject Matter

9. Claims 42-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Haga et al. 4,890,770 and Walsh et al. D510266 disclose other types of insert for a container.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick C. Nicolas whose telephone number is (571)-272-4931. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Y. Mar, can be reached on 571-272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FN
December 20, 2005


 12/20/05
Frederick C. Nicolas
Primary Examiner
Art Unit 3754

FIG. 8

10

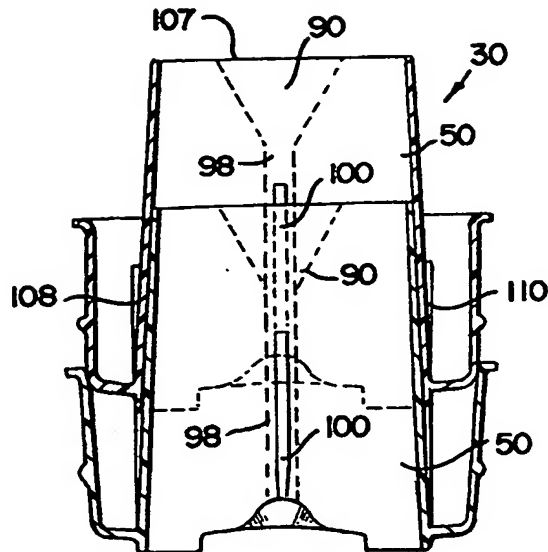


FIG. 9

200

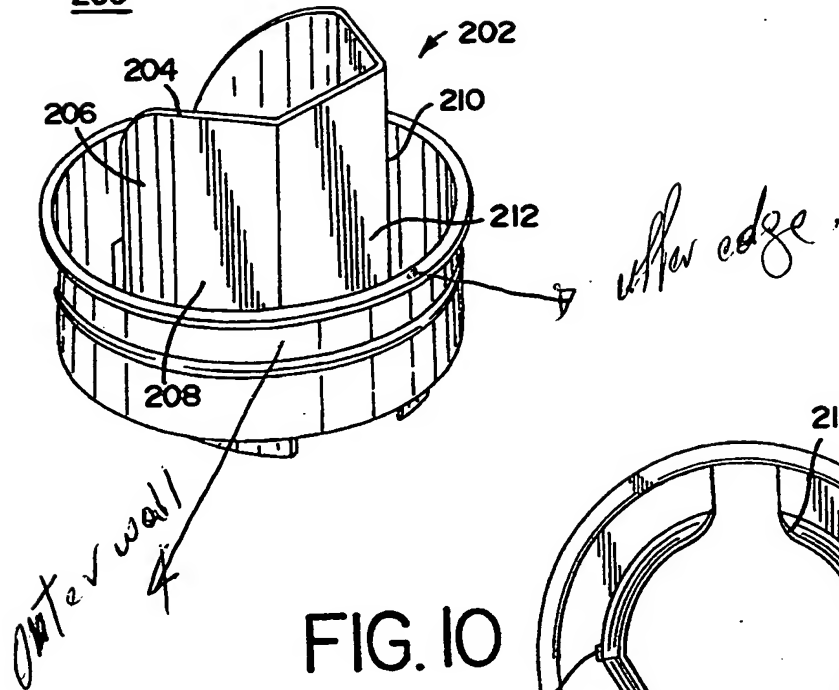


FIG. 10

